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In re Application of	:	
MYERS, et al.	:	
Application No.: 08/809,677	:	DECISION ON RENEWED
PCT No.: PCT/US94/10935	:	
Int. Filing Date: 27 September 1994	:	PETITION UNDER
Priority Date: 27 September 1994	:	
Attorney Docket No.: 07354/004001	:	37 CFR 1.47(b)
For: ARTIFICIAL LIVER APPARATUS AND	:	
METHOD	:	

This is a decision on applicant's "Supplemented and Restated Petition Under 37 C.F.R. §1.47" filed in the United States Patent and Trademark Office (USPTO) on 24 September 2001.

### **BACKGROUND**

On 15 August 2001, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Applicant was afforded two months to file a response.

On 24 September 2001, applicant responded with the present renewed petition under 37 CFR 1.47(b).

On 23 October 2001, applicant filed a combined declaration and power of attorney executed by Gregory F. Szabo, president of Xenogenics Corporation.

### **DISCUSSION**

As discussed in the decision mailed 15 August 2001, a petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(1); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant

Now satisfied item (6) above

As to item (2), in the decision mailed 15 August 2001 applicant was advised that, "in order to proceed pursuant to 37 CFR 1.47(b) applicant must show an actual refusal by the non-signing inventor to execute the declaration or silence on the part of the non-signing inventor after a complete set of application papers have been presented to him." It appears from the renewed petition and supporting exhibits that non-signing inventors Li and Myers were presented merely with a cover letter and declaration for signing. In addition, while applicant claims that Drs. Li and Myers have refused to execute an oath or declaration, applicant has not provided a statement from an individual with firsthand knowledge of the alleged refusals of Li and Myers. As to inventor Demetriou, applicant has satisfied this item as applicant has provided proof in the form of a letter from Dr. Demetriou's counsel that he will not sign documents related to the present application; moreover, as indicated in Exhibit A, a copy of the application and declaration was sent to Dr. Demetriou. As detailed above, applicant has not satisfied item (2) as to inventors Li and Myers.

Regarding item (4), the submitted declaration fails to comply with 37 CFR 1.497(b) in that, 37 CFR 1.497(b)(2) states that in cases where the person making the oath or declaration is not the inventor, "[T]he oath or declaration shall state the relationship of the person to the inventor..." The present declaration does not contain such a statement.

As to item (5), applicant has failed to show proof of proprietary interest in the application. Section 409.03(f) details the procedures for providing proof of proprietary interest when proceeding under 37 CFR 1.47(b):

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). An assignment to a 37 CFR 1.47(b) applicant for the sole purpose of obtaining a filing date for a 37 CFR 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and 37 CFR 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application to the applicant, a copy of the agreement should be submitted. If

an employment agreement where an employee is obligated to assign to the employer or her employer (37 CFR 1.47(b) applicant) all inventions made during employment

When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

A) Regarding inventor Li, the submitted assignment (Exhibit I) is unsigned. Petitioner's assertion that the "only reason for not signing the assignment was that he thought that he was being asked to sign not only on his own behalf but also on behalf of his co-inventors, Drs. Myers and Demetriou" is speculation. As to Dr. Li's employment agreement (Exhibit H), applicant has failed to provide a statement of a person having firsthand knowledge of the facts that the invention was made by Dr. Li while employed by Xenogenex. In addition, contrary to petitioner's assertion, the agreement does not discuss any obligation to "sign a separate assignment document for the invention." Similarly, regarding applicant's discussion of California employment law, an applicant proceeding under 37 CFR 1.47(b) who is attempting to show a proprietary interest obtained other than by assignment or agreement to assign may demonstrate such status by submission of an appropriate legal memorandum. (MPEP Section 409.03(f)). In the present case applicant has cited specific case law but has not provided a legal memorandum prepared and signed by an attorney indicated as familiar with the law of California as required and based on the requisite affidavit by one with firsthand knowledge.

B) Regarding inventor Myers, the submitted assignment (Exhibit D) does not relate to the present invention. As to applicant's argument that an officer of a corporation owes to that corporation the assignment of all technical developments made by the officer in the course of his employment and material to the business of the corporation, applicant has not provided a legal memorandum prepared and signed by an attorney at law familiar with the law of California as required. (See MPEP Section 409.03(f) and discussion above.)

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Thus, Xenogenics (the 1.47(b) applicant) has failed to establish proprietary interest in the present application.

For the above reasons, it would not be appropriate to accept this application without the signatures of Drs. Myers, Li and Demetriou.

### CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mailing date of this decision. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Should status under 37 CFR 1.47(b) not be successfully completed, the international application will be viewed as having become abandoned with respect to the United States of America at midnight at the expiration of the time period set in this decision or as extended by any extension fee timely paid under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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